| TRANSMITTAL OF APPEAL BRIEF (Small Entity) | Docket No. MRJ-10202/03 |
|---|---|



In Re Application Of: **Mankovitz**

| Application No. | Filing Date | Examiner | Customer No. | Group Art Unit | Confirmation No. |
|---|---|---|---|---|---|
| 09/677,424 | 10/02/2000 | H. Nguyen | 25006 | 2662 | |

Invention: **ELECTRONIC TELEVISION PROGRAM GUIDE DELIVERY SYSTEM USING TELEPHONE TIME**

COMMISSIONER FOR PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:

☒ Applicant claims small entity status. See 37 CFR 1.27

The fee for filing this Appeal Brief is: **$170.00**

☒ A check in the amount of the fee is enclosed.

☐ The Director has already been authorized to charge fees in this application to a Deposit Account.

☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. **07-1180**

☐ Payment by credit card. Form PTO-2038 is attached.

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

*Signature*

Dated: **Oct. 25, 2004**

**John G. Posa**
**Reg. No. 37,424**
**Gifford, Krass, Groh**
**280 N. Old Woodward Ave., Suite 400**
**Birmingham, MI 48009**
**Tel. 734/913-9300**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on **Oct. 25, 2004** (Date)

*Signature of Person Mailing Correspondence*

**Sheryl L. Hammer**

*Typed or Printed Name of Person Mailing Correspondence*

cc:

JFW AF

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
# BOARD OF PATENT APPEALS AND INTERFERENCES

GIFFORD, KRASS, GROH, SPRINKLE, ANDERSON & CITKOWSKI, P.C. 280 N. OLD WOODWARD AVENUE, STE. 400, BIRMINGHAM, MICHIGAN 48009-5394 (248) 647-6000

In re application of: Mankovitz

Serial No.: 09/677,424 Group No.: 2662

Filed: Oct. 2, 2000 Examiner: H. Nguyen

For: ELECTRONIC TELEVISION PROGRAM GUIDE DELIVERY SYSTEM USING TELEPHONE NETWORK IDLE TIME

## APPELLANT'S BRIEF UNDER 37 CFR §1.192

Mail Stop Appeal Brief
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

### I. Real Party in Interest

The real party in interest in this case is Roy J. Mankovitz, Applicant and Appellant.

### II. Related Appeals and Interferences

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

### III. Status of Claims

The present application was filed with 20 claims, and all are currently pending, rejected and under appeal.

### IV. Status of Amendments Filed Subsequent Final Rejection

No after-final amendments have been filed.

GIFFORD, KRASS, GROH, SPRINKLE, ANDERSON & CITKOWSKI, P.C. 280 N. OLD WOODWARD AVENUE, STE. 400, BIRMINGHAM, MICHIGAN 48009-5394 (248) 647-6000

## V. Summary of Claimed Subject Matter

Independent claim 1 resides in a method of providing electronic television program guide information to a user over a telecommunications network including the capability of determining whether the user's connection to the network is in an on-hook or off-hook condition (Figure 1, item 22). The method includes the steps of storing television program guide information at a provider site on the network (Figure 1, item 28), and repetitively transmitting the information over the network regardless of whether the user's connection to the network is in an on-hook or off-hook condition (Figure 2). The method further includes the steps of receiving at least a portion of the information at a user site when the user's connection to the network is in an on-hook condition; storing the received information at the user site; and updating the information as it is received (Specification, page 4 line 10 to page 5 line 7; Figure 1).

Independent claim 10 provides for a system for providing information to a user in electronic form over a telecommunications network, the network including the capability of determining whether the user's connection to the network is in an on-hook or off-hook condition (Figure 1, item 22). The system comprises an information provider including a database for storing the information (Figure 1, item 28), and an interface enabling requested information to be repetitively delivered over the telecommunications network regardless of whether user's connection to the network is in an on-hook or off-hook condition (Figure 2). A user site includes a storage device and a splitter interfaced to the network for routing the information from the provider to the storage device and updating the information when the user's connection to the network is in an on-hook condition. (Specification, page 4 line 10 to page 5 line 7; Figure 1, item 12)

## VI. Grounds of Rejection to be Reviewed on Appeal

1. Claim 10 is rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,353,337 to Tsumura et al.

2. Claims 1-6, 8, 9, 11-17, 19 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,353,337 to Tsumura et al., in view of U.S. Patent No. 6,442,755 to Lemmons et al.

GIFFORD, KRASS, GROH, SPRINKLE, ANDERSON & CITKOWSKI, P.C. 280 N. OLD WOODWARD AVENUE, STE. 400, BIRMINGHAM, MICHIGAN 48009-5394 (248) 647-6000

3. Claim 7 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,353,337 to Tsumura et al., in view of U.S. Patent No. 6,442,755 to Lemmons et al., and further in view of U.S. Patent No. 5,357,505 to Tsumura et al.

## VII. Argument

A. Claim 10

Claim 10 stands rejected under 35 U.S.C. §102(e) over Tsumura et al., U.S. Patent No. 5,353,337. Examiner has either misread or misinterpreted this reference. Claim 10 includes, among other limitations, "an interface enabling requested information to be repetitively delivered over [a] telecommunications network regardless of whether user's connection to the network is in an on-hook or off-hook condition."

The Examiner claims that Tsumura et al. discloses such a limitation, but the undersigned cannot find language in the '337 patent to support this argument. More particularly, the Examiner states that

> "center 10 ... includes database 12 storing compound data to continuously deliver music or image to the telephone exchange 20 regardless of the condition of the condition [sic] of switch 22 on the telephone line 40 in the telephone exchange."

However, reference is made to column 4, lines 47-61 of the '337 patent, which is reproduced herein below:

> "In the sort of configuration outlined above, when the telephone receiver is lifted off the hook, the exchange device 22 is switched to the exchange switching system to enable voice communication and, when the telephone receiver is placed on hook, the exchange device 22 is switched, during periods when the telephone line 40 is idle, to one or other of the center units to enable the idle time to be used for the transmission of broadcast signals from one or other of said center units 11, 11', 11'' by way of said telephone line 40 to the two aforementioned terminals 33a, 33b. Remote operating instructions can also be sent from said terminals 33a, 33b to turn the exchange unit 22 on and off and to select the required center unit (in other words, to change channels).

Thus, by Applicant's understanding, data transmission under Tsumura commences only when the receiver is in an on-hook condition, and not regardless of whether it is an on-hook or off-hook condition. Nor can Applicant find any disclosure whatsoever that information is sent repetitively, but rather, is sent when an on-hook condition is detected. Thus, the systems of Tsumura et al. and that of Applicant are entirely different, precluding anticipation.

GIFFORD, KRASS, GROH, SPRINKLE, ANDERSON & CITKOWSKI, P.C. 280 N. OLD WOODWARD AVENUE, STE. 400, BIRMINGHAM, MICHIGAN 48009-5394 (248) 647-6000

B. Rejection of Claims 1-6, 8, 9, 11-17, 19 and 20 under 35 U.S.C. §103(a)

Independent Claim 1.

Claim 1 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,353,337 to Tsumura et al., in view of U.S. Patent No. 6,442,755 to Lemmons et al. The Examiner has failed to establish *prima facie* obviousness.

First, Tsumura does not disclose or suggest the information set forth by the Examiner. Among other limitations, Tsumura does not teach the step of "repetitively transmitting the information over the network regardless of whether the user's connection to the network is in an on-hook or off-hook condition." Rather, data transmission under Tsumura commences only when the receiver is in an on-hook condition, and not regardless of whether it is an on-hook or off-hook condition. Nor can Applicant find any disclosure whatsoever that information is sent repetitively, but rather, is sent when an on-hook condition is detected (see Tsumura, column 4, lines 47-61). Thus even if Tsumura and Lemmons were properly combinable, Appellant's invention as claimed would not result.

Moreover, the Tsumura/Lemmons combination is unjustified. In rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to combine the cited references to arrive at Applicant's claimed invention. There must be something *in the prior art* that suggests the proposed combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior-art references. In Re Dembeczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

In this case, the Examiner concedes that Tsumura is silent with respect program guide information, but attempts to add Lemmons to address this deficiency. But Tsumura makes no mention of program guide information, and Lemmons has nothing to do with on-hook/off-hook conditions or other aspects of Appellant's invention. Accordingly, the Examiner has failed to establish *prima facie* obviousness.

GIFFORD, KRASS, GROH, SPRINKLE, ANDERSON & CITKOWSKI, P.C. 280 N. OLD WOODWARD AVENUE, STE. 400, BIRMINGHAM, MICHIGAN 48009-5394 (248) 647-6000

C. Rejection of Claim 7 under 35 U.S.C. §103(a).

Claim 7

Claim 7 includes the limitation of transmitting the information in the form of serial data packets and reconstructing the packets at the user site. Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,353,337 to Tsumura et al., in view of U.S. Patent No. 6,442,755 to Lemmons et al., and further in view of U.S. Patent No. 5,357,505 to Tsumura et al. The Examiner concedes that Tsumura '337 fails to teach transmitting information in the form of serial data packets, and reconstructing the packets at the user's site, but claims that it would have been obvious to use the teaching of Tsumura '505 to modify Tsumura '337

> "in order to not only have unidirectional one-too-many communications from the center unit 10 to a plurality of home devices ... but allow transmitting information in data form to a center ... while at the same time enabling error-free communication to be carried out between control device and terminal [sic]."

Apart from being difficult to understand, this "motivation to combine" does not seem to have any relevance to Appellant's point of novelty, at least with respect to the claims at issue. While Appellant's system does facilitate one-too-many type communications with error free transmissions through redundant send/receive patterns, Appellant's system and method could be used with a single head end to a single user, and many other types of technologies could be used to facilitate "error-free" transmissions. Thus, given the lack of any motivation to combine from the prior art, and the lack of justification to combine the references, prima facie obviousness has not been established.

**Conclusion**

In conclusion, for the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and Appellant seek the Board's concurrence at this time.

Respectfully submitted,

By: _____

Date: Oct. 25, 2004

John G. Posa
Reg. No. 34,424
Gifford, Krass, Groh, Sprinkle,
Anderson & Citkowski, P.C.
280 N. Old Woodward, Suite 400
Birmingham, MI 48009
(734) 913-9300

## APPENDIX A

## CLAIMS ON APPEAL

1. A method of providing electronic television program guide information to a user over a telecommunications network including the capability of determining whether the user's connection to the network is in an on-hook or off-hook condition, the method comprising the steps of:

storing television program guide information at a provider site on the network;

repetitively transmitting the information over the network regardless of whether the user's connection to the network is in an on-hook or off-hook condition;

receiving at least a portion of the information at a user site when the user's connection to the network is in an on-hook condition;

storing the received information at the user site; and

updating the information as it is received.

2. The method of claim 1, further including the step of displaying the information at the user site.

3. The method of claim 1, further including the steps of:

encoding the information at the provider site prior to transmitting; and

decoding the information at the user site.

4. The method of claim 1, further including the step of simultaneously transmitting the information to a plurality of user sites.

5. The method of claim 1, wherein the step of delivering the information to a user site over the network in wireless fashion.

6. The method of claim 1, including the step of repeating the transmission of the information to maximize the amount of information delivered to the user in the event of an off-hook or

other network interruption.

7. The method of claim 1, including the steps of:
transmitting the information in the form of serial data packets; and
reconstructing the packets at the user site.

8. The method of claim 1, including the steps of:
encrypting the information prior to transmission; and
decrypting the information at the user site.

9. The method of claim 1, further including the step of filtering out voice or data signals received over the network when the user's connection is in an off-hook condition.

10. A system for providing information to a user in electronic form over a telecommunications network, the network including the capability of determining whether the user's connection to the network is in an on-hook or off-hook condition, the system comprising:

an information provider including a database for storing the information and an interface enabling requested information to be repetitively delivered over the telecommunications network regardless of whether user's connection to the network is in an on-hook or off-hook condition; and

a user site including a storage device and a splitter interfaced to the network for routing the information from the provider to the storage device and updating the information when the user's connection to the network is in an on-hook condition.

11. The system of claim 10, wherein the information relates to a television program.

12. The system of claim 11, wherein the information is television program schedule information.

13. The system of claim 12, wherein:

GIFFORD, KRASS, GROH, SPRINKLE, ANDERSON & CITKOWSKI, P.C. 280 N. OLD WOODWARD AVENUE, STE. 400, BIRMINGHAM, MICHIGAN 48009-5394 (248) 647-6000

the user site further includes a television display; and

the storage device is interfaced to the television display enabling the user to view the program schedule information.

14. The system of claim 10, wherein:

the information is delivered in encoded form; and

the user site includes a decoder to decode the information.

15. The system of claim 10, further including:

a plurality of user sites, each equipped with a splitter interfaced to the network for receiving the information from the provider.

16. The system of claim 10, wherein at least a portion of the network is wireless.

17. The system of claim 10, wherein the transmission of the information is repeated to maximize the amount of information delivered to the user in the event of an off-hook or other network interruption.

18. The system of claim 17, wherein the information is transmitted in the form of serial data packets which are reconstructed at the user's site.

19. The system of claim 10, further including circuitry to the user's site for filtering out voice or data signals received over the network when the user's connection is in an off-hook conditions.

20. The system of claim 10, wherein the information is encrypted using a time-dependent code.

GIFFORD, KRASS, GROH, SPRINKLE, ANDERSON & CITKOWSKI, P.C. 280 N. OLD WOODWARD AVENUE, STE. 400, BIRMINGHAM, MICHIGAN 48009-5394 (248) 647-6000

## APPENDIX B

## EVIDENCE

None.

GIFFORD, KRASS, GROH, SPRINKLE, ANDERSON & CITKOWSKI, P.C. 280 N. OLD WOODWARD AVENUE, STE. 400, BIRMINGHAM, MICHIGAN 48009-5394 (248) 647-6000

## APPENDIX C

## RELATED PROCEEDINGS

None.